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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,995	11/30/2001	Giovanni Frezza	856063.722	3898

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EXAMINER

VU, QUANG D

ART UNIT	PAPER NUMBER
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2811

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,995

Applicant(s)

FREZZA, GIOVANNI

Examiner

Quang D Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment filed on 12/03/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-22 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-22 and 24-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: _____

DETAILED ACTION

Drawings

The corrected or substitute drawings were received on 01/07/03. These drawings are acceptable.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 20, 22, 26, 27 and 29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification never discloses a ring-shaped projection portion structure to enable the electronic device to be activated through the projecting portion when the electronic device is in use as claimed in claim 20. The specification (fig. 8) discloses the ring-shaped projecting layer (51) abutting against the upper wall of the mold cavity during the molding step, prevents that the plastic material covers the inner part (31) of the sensor (30) surrounded by this ring-shaped projecting portion 51.

The specification never discloses the projecting portion is surrounded by dyke or barrier formed on a surface of the electronic circuit while the projecting portion being structured to

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enable the electronic device to be activated through the projecting portion when the electronic device is in use as claimed in claim 22.

The specification never discloses the electronic circuit as claimed in claim 26.

The specification never discloses a ring-shaped projection portion structure to enable the electronic device to be activated through the projecting portion when the electronic device is in use as claimed in claim 27. The specification (fig. 8) discloses the ring-shaped projecting layer (51) abutting against the upper wall of the mold cavity during the molding step, prevents that the plastic material covers the inner part (31) of the sensor (30) surrounded by this ring-shaped projecting portion 51.

The specification never discloses the projecting portion is surrounded by dyke or barrier formed on a surface of the electronic circuit while the projecting portion being structured to enable the electronic device to be activated through the projecting portion when the electronic device is in use as claimed in claim 29.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 24 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24, in line 2, the phrase "...a proximity sensor" is unclear as to what is a proximity sensor. It is being referred to a pressure sensor or an optical sensor?

Claim 30, in line 2, the phrase "...a proximity sensor" is unclear as to what is a proximity sensor. It is being referred to a pressure sensor or an optical sensor?

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 19, 21, 24-25, 28 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,948,991 to Nomura et al.

Regarding claim 19, Nomura et al. (figure 4) teach a packaged electronic device ready for electronic use, comprising:

a semiconductor integrated electronic circuit (11);

a plastic protective package (3) surrounding and supporting the electronic circuit (11), the protective package (3) having a window (3a) over a portion of the electronic device (11) such that the electronic device can be at least partially activated from outside of the protective package (3); and

a projecting portion (15) of elastic material projecting from a surface of the electronic device (11) into the window (3a).

It is inherent that the projecting portion being structured to enable the electronic device to be activated through the projecting portion when the electronic device is in use because a

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pressure sensitive diaphragm (11a) always receive pressure from the top surface of the diaphragm.

Regarding claim 21, Nomura et al. teach the window (3a) has tapering walls toward the electronic circuit (11).

Regarding claim 24, Nomura et al. teach the electronic circuit includes a pressure sensor.

Regarding claim 25, Nomura et al. (figure 6) teach a packaged electronic device ready for electronic use, comprising :

a semiconductor integrated electronic circuit (130);

a plastic protective package (122) surrounding and supporting the electronic circuit (130), the protective package (122) having a window (127) over a portion of the electronic device such that the electronic device can be activated from outside of the protective package (122); and

an elastic protective layer (132) positioned in the window (127).

It is inherent that the protective layer being structured to enable the electronic device to be activated through the protective layer when the electronic device is in use because a pressure sensitive diaphragm (11a) always receive pressure from the top surface of the diaphragm.

Regarding claim 28, Nomura et al. teach the window (127) has walls tapering toward the electronic circuit (130).

Regarding claim 30, Nomura et al. teach the electronic circuit (130) includes a pressure sensor.

Response to Arguments

Applicant's arguments with respect to claims 19-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang D Vu whose telephone number is 703-305-3826. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Thomas can be reached on 703-308-2772. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

qv

March 10, 2003

Steven Lohr